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Appl. No. 10/562,742  
Response to Office Action mailed September 24, 2008

OCT 16 2008

R E M A R K S

Priority Under 35 USC 119

The Examiner is respectfully requested to acknowledge applicants' claim for priority under 35 USC 119 and receipt of the certified copy of the priority document.

Information Disclosure Statement

The Examiner is also respectfully requested to return copies of the Forms PTO/SB/08A and PTO/SB/08B filed on December 21, 2006, and to indicate thereon that all the cited publications were considered and made of record.

Drawing

The Examiner is respectfully requested to approve the drawing.

Restriction Requirement

Restriction was required under 35 USC 121 as follows:

Group I. Claims 10, 12, 14, 16, 18, 20, 22 and 24, drawn to a method for inhibiting a pain threshold

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decrease comprising administering to a patient an effective amount of a  $\kappa$ -opioid receptor agonist; and

Group II. Claims 11, 13, 15, 17, 19, 21, 23 and 25, drawn to a method for treating chronic pain comprising administering to a patient an effective amount of a  $\kappa$ -opioid receptor agonist.

Applicant elects Group II (claims 11, 13, 15, 17, 19, 21, 23 and 25) directed to a method for treating chronic pain.

For the reason set forth beginning on page 4 and continuing to page 5 of the Office Action, applicants were required to make a species election.

Applicants elect Compound C, namely (+)-3-acetyl-6-chloro-2-[2-(3-(N-(2-ethoxyethyl)-N-isopropylamino)propoxy)-5-methoxyphenyl]benzothiazolinediacetyl tartrate. This compound is disclosed on page 16, lines 5 to 7 of the specification.

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The claims readable on the elected species are claims 11, 13, 15 and 25.

The Restriction Requirement concerning the election of a species is respectfully traversed on the ground that it is not a species requirement of the type set forth in MPEP 803.02 entitled "MARKUSH CLAIMS." It is respectfully submitted that the practice set forth therein and in the decisions cited in MPEP 803.02 are the proper practice to be applied in the present case and to the extent that the Restriction Requirement is not consistent therewith, it is respectfully traversed.

If, however, the Restriction Requirement is maintained, then taking into consideration that there are generic claims, it is respectfully requested that the provisions of 37 CFR 1.141(a) and the procedure set forth in MPEP 806.04(d) be followed, which provide that once a claim that is determined to be generic is allowed, all the claims drawn to species, in addition to the elected species, which include all the limitations of the generic claim, should be allowed.

Reconsideration is respectfully requested.

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If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

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RSB/ddf

Respectfully submitted,

  
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